

FUJ 17.041 (100794-11377)  
09/526,391REMARKS

This amendment is in response to the Examiner's Office Action dated 3/30/2004. This amendment should obviate outstanding issues and make the remaining claims allowable. Reconsideration of this application is respectfully requested in view of the foregoing amendment and the remarks that follow.

STATUS OF CLAIMS

Claims 1-9 are pending.

Claim 7 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Lee (USP 5,517,549).

Claim 8 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Krolopp et al. (USP 4,811,377).

Claims 1-3 and 5-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Toru (JP 08-182052) in view of Hiroshi (JP 9-252489) and further in view of Lee (USP 5,517,549) or Krolopp et al. (USP 4,811,377) or Smith (USP 4,630,314).

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Toru (JP 08-182052) in view of Hiroshi (JP 9-252489) and further in view of Lee (USP 5,517,549) or Krolopp et al. (USP 4,811,377) or Smith (USP 4,630,314) and further in view of Mills (USP 5,915,225).

REJECTIONS UNDER 37 USC § 102

Claim 7 stands rejected under 35 USC §102 as anticipated by Lee (U.S. Pat. No. 5,517,549). Claim 7 has been amended to recite that the memorizing apparatus includes a dialing

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unit for dialing a number of the portable telephone to connect with the portable telephone via one of the base stations. The retrieval of rental billing information from portable handsets as taught by Lee do not identically disclose the dialing unit of the memorizing apparatus as recited in amended claim 7. Accordingly reconsideration and withdrawal of the rejection under 35 USC §102 of claim 7 are respectfully requested.

Claim 8 stands rejected under 35 USC §102 as anticipated by either Krolopp et al. (U.S. Pat. No. 4,811,377) or Svensson (U.S. Pat. No. 5,687,216). Claim 8 has been amended to recite that the receiving unit of the portable telephone set receives an incoming call from the memorizing unit via a base station in response to the memorizing unit dialing the number of the portable telephone. Neither Svensson or Krolopp et al. identically disclose receiving an incoming call via a memorizing apparatus dialing a portable telephone set's number as recited in amended claim 8. Accordingly reconsideration and withdrawal of the rejection under 35 USC §102 of claim 8 are respectfully requested.

#### REJECTIONS UNDER 37 USC § 103

Claims 1-3, 5 and 6 stand rejected under 35 USC §103 as unpatentable over Toru Nishio (JP 08-182052, hereinafter "Toru") in view of Hiroshi Ogasawara (JP 9-252489, hereinafter "Ogasawara") further in view of any of Lee, Krolopp et al, or Smith (U.S. Pat. No. 4,630,314). The Examiner contends that Toru teaches a portable telephone that can have its internal memory backed-up by a base station at a scheduled backup time. The Examiner admits that Toru does not teach the performing the backup without first scheduling it. However, the Examiner contends that Ogasawara teaches backups "without taking into account a time factor" and concludes that it would have been obvious to combine the two references because doing so would make "it possible to request information backup anytime desired." The Examiner admits that the

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combination of Toru and Ogasawara fail to teach or suggest erasing the memory of the device once data has been transferred or received. However, the Examiner relies on a number of secondary references that teach erasing information in memory. The Examiner concludes that it would have been obvious to combine the references to conserve memory space and reduce storage redundancy.

Claim 1 has been amended to recite that the maintenance service center includes a dialing unit that dials the number of the portable telephone set to connect with the portable telephone. Similarly, claim 3 has been amended to recite that the portable telephone set is accessed from the maintenance service center by a dialing unit dialing a portable telephone number of the portable telephone to connect with the portable telephone set. In contrast, Toru does not teach or suggest a maintenance service center having a dialing unit or performing dialing to a portable telephone. Furthermore, in Toru it is a particular base station that sends controlling codes for data backup to the "PHS terminal"; thus, in Toru when the PHS terminal moves to a different coverage area, the PHS is unable to receive the controlling codes. Ogasawara does not teach or suggest the dialing unit of the maintenance service center either. In Ogasawara, in contrast to the claims as amended, the backup of information is performed between a communication terminal and a fixed telephone.

Thus, both Ogasawara and Toru fail to teach or suggest the maintenance service center having a dialing unit that dials the number of the portable telephone to connect with the portable telephone set as recited in claims 1 and 3 as amended. The secondary references of Lee, Krolopp et al. and Smith also do not teach or suggest such a maintenance service center. Thus, even if combined together, the references fail to disclose or suggest all the limitations recited in claims 1 and 3. Accordingly, this combination of references does not provide the factual foundation to

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support a prima facie case of obviousness under 35 USC §103. Thus, reconsideration and withdrawal of the rejection of claims 1-3, 5 and 6 under 35 USC §103 are respectfully requested.

Claim 4 stands rejected under 35 USC §103 as unpatentable over Toru in view of Ogasawara further in view of Lee, Krolopp et al, or Smith and further in view of Mills (U.S. Pat. No. 5,915,225). The Examiner admits that the primary combination of references fails to teach "making a request to a phone in a busy state" but asserts that Mills teaches remotely retrieving stored data over a connection-less link where a request can be made to a telephone even in a busy state. The Examiner concludes that it would have been obvious to combine these references because doing so would make "it possible to program and communicate with a device in a busy state." For the reasons provided above, Applicants urge that the primary combination of references do not teach all the limitations of the base claim from which claim 4 depends. Even if Mills teaches the specific limitation recited in claim 4, Applicants urge that Mills does not cure the deficiencies of the primary references with respect to claim 3. Thus, the combination of the primary references with Mills does not disclose or suggest all the limitations recited in claim 4. Accordingly, this combination of references does not provide the factual foundation to support a prima facie case of obviousness under 35 USC §103. Thus, reconsideration and withdrawal of the rejection of claim 4 under 35 USC §103 are respectfully requested.

Claim 9 stands rejected under 35 USC §103 as unpatentable over Mills in view of Lee. The Examiner contends that one of ordinary skill would have been motivated to combine these two references to arrive at the claimed invention because it would make "it possible to update, request and configure telephones even in a busy state." Claim 9 has been amended to recite that the receiving unit of the portable telephone set receives an incoming call from the memorizing unit via a base station in response to the memorizing unit dialing the number of the portable telephone. Neither Lee nor Mills disclose or suggest receiving an incoming call via a

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memorizing apparatus dialing a portable telephone set's number as recited in claim 9 as amended. Thus, the combination of Lee and Mills does not disclose or suggest all the limitations recited in amended claim 9. Accordingly, this combination of references does not provide the factual foundation to support a prima facie case of obviousness under 35 USC §103. Thus, reconsideration and withdrawal of the rejection of claim 9 under 35 USC §103 are respectfully requested.

#### SUMMARY

As has been detailed above, none of the references, cited or applied, provide for the specific claimed details of applicant's presently claimed invention, nor renders them obvious. It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested.

A petition for extension of time has been filed with this amendment.

If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicant's representative at the below number.

Respectfully submitted,



Brian S. Myers  
Registration No. 46,947

Katten Muchin Zavis Rosenman  
575 Madison Avenue  
New York, NY 10022-2585  
(212) 940-8703  
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